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Remarks

Reconsideration of the above-captioned application is respectfully requested. Claims 12 and 14 have been rejected under 35 U.S.C. §102 as being anticipated by Matthews, III et al. (USPN 5,914,746, hereinafter "Matthews"), and Claims 1, 2, 4, 5, 7, and 13 have been rejected under 35 U.S.C. §103 as being unpatentable over Matthews. Claim 3 has been rejected under 35 U.S.C. §103 as being unpatentable over Matthews in view of Dunn et al., USPN 6,584,613, Claim 6 has been rejected under 35 U.S.C. §103 as being unpatentable over Matthews in view of Stinebruner, USPN 6,133,910, and Claims 8-11 have been rejected under 35 U.S.C. §103 as being unpatentable over Matthews in view of Watson, USPN 5,289,271.

The fact that Applicant has focussed its comments distinguishing the present claims from the applied references and countering certain rejections must not be construed as acquiescence in other portions of rejections not specifically addressed.

To overcome the Examiner's rejections, Claim 1 has been amended to recite setting a restriction flag on at least one entry in the table, with the flag indicating whether content associated with the entry can be displayed as disclosed on page 4, lines 9-11. In contrast, Claim 2 has been amended to recite that at least one virtual channel number is a telephone number as disclosed on page 13, last four lines continuing to page 14, first two lines. Independent Claim 7 now requires recording an accessing of a Web site to render at least one access record containing billing information as disclosed on page 14, lines 1-10. Independent Claim 12 as now amended recites a particular billing paradigm set forth on page 14, last paragraph continuing to page 15, line 4. Claims 1, 2, 4-7, and 9-14 remain pending.

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Rejections Under 35 U.S.C. §102

To support an anticipation rejection, every claim element must be taught or inherent in a single prior art reference, Manual of Patent Examining Procedure (MPEP) §2131. Claims 12 and 14 have been rejected under 35 U.S.C. §102 as being anticipated by Matthews, which nowhere teaches or suggests a particular billing paradigm much less the one now set forth in Claim 12 which includes billing an entity associated with a private content source for user accesses thereto but billing the user for accessing public content sources.

Rejections Under 35 U.S.C. §103

Claims 1, 2, 4, 5, 7, and 13 have been rejected under 35 U.S.C. §103 as being unpatentable over Matthews. Claim 3 has been rejected under 35 U.S.C. §103 as being unpatentable over Matthews in view of Dunn et al., USPN 6,584,613, Claim 6 has been rejected under 35 U.S.C. §103 as being unpatentable over Matthews in view of Stinebruner, USPN 6,133,910, and Claims 8-11 have been rejected under 35 U.S.C. §103 as being unpatentable over Matthews in view of Watson, USPN 5,289,271.

Of relevance to amended Claim 1 is the allegation that the flag of Claim 6 is taught by Stinebruner, and the admission in the Office Action that Matthews fails to teach virtual channels that are based on Web pages. The reason is as follows. There is no prior art suggestion to combine the parental lock flag of Stinebruner, which is used to prevent children from accessing objectionable Web sites, in the relied-upon table of Matthews, which presents, as "virtual channels", only executable code sources for, e.g., executing an electronic program guide (EPG). Because an EPG is in effect an index of available stations but does not typically display content, objectionable or not, there is no reason to use the parental flag of Stinebruner in the virtual channel table of Matthews.

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Although admitting that Matthews fails to teach Web pages for its virtual channels, the examiner takes "official notice that it is notoriously well known for an online service to use web sites". However, neither Matthews nor Claim 1 are directed to "online services" in a vacuum. Claim 1 recites a method related to an ITV. While Web sites in a vacuum are known, accessing Web sites using ITVs is another matter. Furthermore, using a particularly claimed data structure in an ITV with a particularly claimed data element to perform a particularly claimed function cannot be bootstrapped into a "well known" fact simply because the claim touches on Web sites. What remains to be shown, to properly comply with the MPEP, is where the prior art suggests the particular combination of elements set forth in Claim 1.

While the above discussion is directed to the merits of the official notice underpinning the rejection of Claim 1, it must not be assumed that Applicant agrees with the taking of official notice in the first place, a ploy that is becoming somewhat common of late despite the guidance of MPEP §2144.03. Specifically, the MPEP advises that the taking of official notice can be taken only of facts that "are capable of instant and unquestionable demonstration as to defy dispute", giving, as examples, adjusting flame intensity as needed for heat and tape recorders automatically erasing old data when new data is recorded onto them. Official notice of dependent claim limitations "might be appropriate" but only if the facts so noticed "are of notorious character".

Accordingly, official notice "is permissible only in some circumstances", and should be "rare" in final rejections. In any case, according to the MPEP official notice is most inappropriate of technical facts in areas of esoteric technology or of specific knowledge of the prior art. Still further, "ordinarily there must be some form of evidence in the record to support an assertion of common knowledge", and "general conclusions

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concerning what is basic knowledge without specific factual findings will not support an obviousness rejection."

It must be noted in addition that the question is not just whether various elements are well known, but also where the prior art supplies the motivation to combine the allegedly well-known features with the rest of the claimed elements. That is, regardless of how an element is identified in the prior art, i.e., using a reference or "official notice", the remaining task for an examiner is to show why the prior art suggests the element in the combination claimed.

With the above legal requirements in mind, it would seem dispositive toward patentability that in essence the use of a table of web page-based virtual channels in an interactive television, to most people an esoteric technology, is anything but "capable of instant and unquestionable demonstration as to defy dispute". The test for taking official notice under the MPEP not having been complied with, the rejections are overcome.

For each and every taking of official notice, should the rejections be persisted in Applicant hereby requests not only a prior art showing under MPEP §2144.03 but also the requisite prior art suggestion to combine the allegedly well-known feature in the combination being rejected. Applicant explicitly traverses the taking of official notice for reasons above.

Turning to Claim 2, in addition to improperly taking official notice for the same reasons noted above, of further relevance is the rejection of former Claim 3 alleging that Dunn et al., col. 2, lines 25-27 teaches using a telephone to generate a virtual channel number. What this portion of Dunn et al. actually teaches is that the server that receives the user's phone call generates the channel number from the "viewer telephone and cable profiles", not that a virtual channel number *is itself* a telephone number as now set forth in Claim

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2. Read in its entirety, it is evident that Dunn et al. actually generates no channel number, but more accurately recovers it from the information in the user's phone call, see, e.g., col. 6, lines 34-42 and col. 7, line 62 continuing to col. 8, line 14. Disclosures in a reference cannot be taken out of context; rather, the reference must be read in its entirety for what it suggests to the skilled artisan, MPEP §2141.02. With this in mind, it seems fair to say that Dunn et al. does not teach a virtual channel which is a telephone number, but rather recovering a virtual channel number using information (including caller ID) from a phone call so that the channel that displayed the product selected by the user can be determined.

Next considering independent Claim 7, in addition to improperly taking official notice for the same reasons noted above, of further relevance is the rejection of former Claim 8 based on the allegation that Watson teaches recording user access. However, the relied-upon portion of Watson discusses recording when a user is tuned to a non-virtual channel, for billing for conventional cable TV channels. It does not relate to virtual channels, much less to Web site-based virtual channels. Accordingly, if Watson were to be combined with Matthews as proposed, Claim 7 (which requires recording accessing of a Web site to render records containing billing information) would not result, but rather only the combined features taught in the references, namely, Matthews' list of virtual and non-virtual channels with the user being billed for the amount of time spent tuned to a non-virtual channel as taught by Watson.

The limitation of dependent Claim 11 has been rejected without evidentiary support but rather only what amounts to a conjecture of what would be obvious to the skilled artisan, and for that additional reason the rejection of Claim 11 is overcome.


The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

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